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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/148,832	09/04/1998	HIROTOSHI MAEGAWA	P3203-8003	4033

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EXAMINER

HAYES, JOHN W

ART UNIT PAPER NUMBER

3621

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/148,832

Applicant(s)

MAEGAWA ET AL.

Examiner

John W Hayes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 May 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 1998 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on 29 April 2002 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/148,832 is acceptable and a CPA has been established. An action on the CPA follows.

### ***Status of Claims***

2. Applicant has canceled claim 1, amended claims 2, 18 and 35, and added new claim 52. Thus, claims 2-52 remain pending and are presented for examination.

### ***Response to Arguments***

3. Applicant's arguments filed 24 May 2002 have been fully considered but they are not persuasive.

With respect to claims 2-15, 18-32, 35-49 and 52, applicant asserts that Ginter discloses that the "rules and controls" provided to control permissions, usage information, rights and obligations of the participants are treated independently from the content. Thus, applicant argues that Ginter fails to disclose that the device enables any content relating to the transaction to be transmitted between the data server means and the data utilization means such as procedure data, bill data and authentication data for example. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., transmitting any content relating to the transaction such as procedure data, bill data and authentication data) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Examiner respectfully disagrees and directs applicants attention to Ginter (Figure 5A and 19; Col. 57, lines 65-67; Col. 59, lines 23-45) wherein it is disclosed that data "containers" contain data relating to

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both the information content and the "rules and controls" or "permissions" for using the data. Ginter also discloses that the information content and permissions can be distributed together as a traveling object (Col. 137, lines 53-65), rather than independently. Furthermore, Ginter discloses that content relating to the transaction such as billing data, payments, reports are transmitted between the data distributor and the user content utilization device (Figure 2). Thus, the rejection of claims 2-15, 18-32, 35-49 and 52 remain pending and are included below for applicant's convenience.

4. Examiner also notes that the indicated allowability of claims 16-17, 33-34 and 50-51 is withdrawn upon further consideration of the reference to Ginter et al. For further details, see the rejection of these claims below.

#### ***Claim Objections***

5. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 51 been renumbered to claim 52. Applicant added a new claim and numbered this claim 51, which was already pending. Thus, examiner has renumbered this claim to 52. Furthermore, claim 2 was amended to depend upon claim 51, however, examiner assumes that claim 2 was amended in error and should have depended upon new claim 52.

#### ***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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7. Claims 2-52 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al, U.S. Patent No. 5,892,900.

As per claims 52, 18 and 35, Ginter et al disclose a network system (Col. 3, lines 20-25) for suitably distributing any content (Col. 8, lines 23-36; Col. 53, lines 55-60) as a transactable product comprising

- one or more data server means, data utilization means, and transaction management means comprised on the network (Figure 2 and 79-84),
- said data server means and utilization means (Figures 1, 1A and 2 and Col. 54, lines 20-35; Col. 55, lines 32-60) transmit and receive through the network a data package (information package) for which a boundary is set in accordance with an attribute for the transaction, and which includes a data relating to the transaction and an attribute data relating to the transaction which defines the attribute of said data to the transaction (Col. 10, lines 8-31; Col. 46, lines 5-27 and 47-67; Col. 54, line 64-Col. 55 line 11; Col. 56, lines 6-29; Col. 56 line 65-Col. 57 line 24; Col. 57, line 65-Col. 58 line 12; Col. 137, lines 50-65),
- said data server means supply through the network the data package with includes data of said content as data related to the transaction (Col. 56, lines 6-29; Col. 57 line 65-Col. 58 line 12),
- said data utilization means receive the supplied data package, and substantially acquiring said data of said content according to said boundary (Col. 56, lines 25-30; Col. 58, lines 35-50, Col. 60 line 58-Col. 61 line 18; Col. 62, lines 31-50), and
- said transaction management means performs processing relating to the transaction on the basis of said attribute data every time said data package is received by said data server means or said data utilization means (Col. 10, lines 8-31; Col. 46, lines 5-27 and 47-67; Col. 54, lines 33-35; Col. 55, lines 44-48; Col. 58 line 62-Col. 59 line 6)

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As per claims 2, 5, 19, 22, 36 and 39, Ginter et al further disclose a network system wherein the boundary set for said data package includes a boundary relating to charging for a transaction of said content, said information of said predetermined attribute included in the data package includes information relating to charging for said content (Col. 46, lines 14-27; Col. 57 lines 1-8; Col. 58, lines 50-61), and said transaction management means has a charging processing means for carrying out processing based on said information relating to charging every time content delineated by said boundary is newly substantially acquired by said data utilization means (Col. 48, lines 45-48; Col. 55, lines 44-50; Col. 58, lines 35-49).

As per claims 3, 20 and 37, Ginter et al further disclose a network system wherein the boundary set for said data package includes a boundary whereby the content delineated by said boundary is content for which a predetermined property right is set, said information of said predetermined attribute included in the data package includes information relating to said property right of said content (Col. 4, lines 28-40; Col. 7, lines 1-12; Col. 54, line 62-Col. 55 line 11; Col. 56, lines 6-24; Col. 56 line 65-Col. 57 line 8), and said transaction management means has a property right management means for carrying out processing for updating a property right of content acquired based on said information relating to said property right every time content delineated by said boundary is newly substantially acquired by said data utilization means (Col. 10, lines 22-31; Col. 46, lines 48-67; Col. 56, lines 25-30).

As per claims 4, 21 and 38, Ginter et al further disclose a network system wherein the boundary set for said data package includes a boundary whereby the content delineated by the boundary is content which at least delineated into a range for which substantial acquisition has been authorized by an authorization, said information of said predetermined attribute included in the data package includes information relating to authorization for substantial acquisition of said content of said data package (Col. 4, lines 28-40; Col. 7, lines 1-12; Col. 54, line 62-Col. 55 line 11; Col. 56, lines 6-24; Col. 56 line 65-Col. 57 line 8), and said transaction management means has a transaction authorization means for carrying out processing for authorization of transactions to control said substantial acquisition of said content

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based on said information relating to authorization of transactions when said data utilization means attempts to newly substantially acquire content delineated by said boundary (Col. 10, lines 22-31; Col. 46, lines 48-67; Col. 56, lines 25-30).

As per claims 6, 23 and 40, Ginter et al further disclose a network system as set forth in claim 5, wherein the boundary set for said data package includes a boundary whereby the content delineated by the boundary is content which is at least delineated into a range owned by a predetermined owner and for which substantial acquisition has been authorized by an authorization, said information of said predetermined attribute included in the data package includes information relating to ownership of said content (Col. 4, lines 28-40; Col. 7, lines 1-12; Col. 54, line 62-Col. 55 line 11; Col. 56, lines 6-24; Col. 56 line 65-Col. 57 line 8; Col. 135, lines 22-29), and said transaction authorization means of said transaction management means carries out said processing for authorization of transactions based on said information relating to ownership when said data utilization means attempts to newly substantially acquire content delineated by said boundary (Col. 10, lines 22-31; Col. 46, lines 48-67; Col. 56, lines 25-30).

As per claims 7, 24 and 41, Ginter et al further disclose a network system as set forth in claim 6, wherein the boundary set for said data package includes a boundary whereby the content delineated by the boundary is content which is at least delineated into a range which has value as a creative work and for which substantial acquisition has been authorized by an authorization, said information of said predetermined attribute included in the data package includes information relating to a copyright of said content (Col. 4, lines 28-40; Col. 7, lines 1-12; Col. 47, lines 30-35; Col. 54, line 62-Col. 55 line 11; Col. 56, lines 6-24; Col. 56 line 65-Col. 57 line 8), and said transaction authorization means of said transaction management means carries out said processing for authorization of transactions based on said information relating to said copyright when said data utilization means attempts to newly substantially acquire content delineated by said boundary (Col. 10, lines 22-31; Col. 46, lines 48-67; Col. 56, lines 25-30).

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As per claims 8, 25 and 42, Ginter et al further disclose a network system as set forth in claim 7, wherein said information of said predetermined attribute of said data package includes information designating said transaction authorization means for carrying out processing relating to authorization of substantial acquisition and said transaction authorization means is provided on any node on the network and is driven by being called up by said transaction management means based on said information designating said transaction authorization means (Col. 10, lines 22-31; Col. 46, lines 15-27 and 48-67; Col. 48, lines 34-50; Col. 55, lines 44-50; Col. 56, lines 25-30; Col. 56 line 65-Col. 57 line 8; Col. 58, lines 50-67).

As per claims 9, 26 and 43, Ginter et al further disclose network system as set forth in claim 8, wherein the substantial acquisition of said content in said data utilization means includes acquisition of said data package and use of said content based on information relating to control for utilization of said content (Col. 56, lines 25-30; Col. 58, lines 35-50, Col. 60 line 58-Col. 61 line 18; Col. 62, lines 31-50),

As per claims 10, 27 and 44, Ginter et al further disclose a network system as set forth in claim 9, wherein said information relating to control for utilization of said content included in said data package has information for control of said content from the node in which the content exists to the node of the data utilization means and further provision is made of a transmission means for transmitting said content to said data utilization means through said network based on information for controlling said transmission when the data utilization means has requested substantial acquisition of said content (Col. 54, lines 10-32; Col. 54 line 63-Col. 55 line 23; Col. 55 line 62-Col. 56 line 29).

As per claims 11, 28 and 45, Ginter et al further disclose a network system as set forth in claim 10, wherein

- said data package has, as its content, time series continuous data existing on any node on said network and has, as information for control for utilization of said content, information for



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- control of transmission of said time series continuous data to said data utilization means (Col. 8, lines 27-36; Col. 9, lines 10-32; Col. 53, lines 55-60),
- provision is further made of a transmission management means generated on any node on the network for managing the transmission of said time series continuous data based on said information relating to control for utilization of said content when said data utilization means requests substantial acquisition of said time series continuous data (Col. 10, lines 22-32,
  - a transmission means generated by said transmission management means on the node where said time series continuous data exists for acquiring said time series continuous data and transmitting it in a predetermined transfer format (Col. 54, lines 18-32; Col. 55, lines 1-11; Col. 56, lines 6-24), and
  - a reception means generated by said transmission management means on the node where said data utilization means exists for receiving data transmitted by said predetermined format and supplying it to said data utilization means (Col. 56, lines 25-30; Col. 60 line 58-Col. 61 line 18), and
  - a desired location of said time series continuous data is transmitted to said data utilization means and said data utilization means substantially acquires said transmitted time series continuous data through said transmission means and said reception means based on the control of said transmission management means (Col. 56 line 65-Col. 57 line 8).

As per claims 12, 29 and 46, Ginter et al further disclose a network system as set forth in claim 11, wherein said information relating to control for utilization of said content includes information designating a processing means for utilization of said content and all, some, or one of information on a type of the content, a property of the content, restrictions on utilization, owner, creator, type of content, and type of service (Col. 56 line 65-Col. 57 line 24).

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As per claims 13, 30 and 47, Ginter et al further disclose a network system as set forth in claim 12, wherein said data package further included information relating to the nature of the content itself (Col. 267, lines 26-54; Col. 286, lines 7-33).

As per claims 14, 31 and 48, Ginter et al further disclose a network system as set forth in claim 14, wherein any information of said information of the data package is information referring to information substantially existing in another data package (Col. 55, lines 1-11; Col. 56, lines 12-24; Col. 57 line 55-Col. 58 line 13).

As per claims 15-17, 32-34 and 49-51, Ginter et al further disclose a network as set forth in claim 14, wherein said data package substantially has part of information substantially existing in said other data package, a reference request generating means for generating a reference request for referring to the entity of the data when the data utilization means utilizes information of the data package referring to another data package, and a management means for managing information on nodes in the vicinity of any node on the network and for searching for a destination of reference (Figures 2-3, 77 and 80-84; Col. 55, lines 1-11; Col. 56, lines 12-24; Col. 57 line 55-Col. 58 line 13), and furthermore wherein a further provision is made of a data package disposal means for managing the state by which information of the data package is referenced from other data packages and managing the disposal of the data package based on the managed state (Col. 10, lines 8-31; Col. 46, lines 5-27 and 47-67; Col. 54, line 64-Col. 55 line 11; Col. 56, lines 6-29; Col. 56 line 65-Col. 57 line 24; Col. 57, line 65-Col. 58 line 12; Col. 137, lines 50-65) .

### ***Conclusion***

8. The prior art previously made of record and not relied upon is considered pertinent to applicant's disclosure.

- Logston et al disclose a interactive information services control system that allows a customer to use a set top terminal to request interactive digital video, audio and data services from a service provider

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- Billock et al disclose a telecasting service for providing video programs on demand and teach the use of a data package that includes data representing the category, classification, description of the content as well as the content itself
- Brugger discloses a device for the distribution of music information in digital form from a central server to a server using information objects
- Stefik discloses a system for controlling the distribution and use of digital works having attached usage rights where the usage rights are defined
- Iwayama et al disclose a method and device for utilizing data content including a utilization permitting device for generating utilization permission information used to decode data contents desired by a user
- Tsumura discloses an information service whereby multimedia digital information is distributed and wherein control information is added to the information to expedite the use of the information
- Yoshizawa et al disclose an interactive chargeable communication system with a billing system
- McDonald et al disclose a multimedia public communication services distribution method and apparatus with distribution of configuration files.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hayes whose telephone number is (703)306-5447. The examiner can normally be reached Monday through Friday from 5:30 to 3:00.

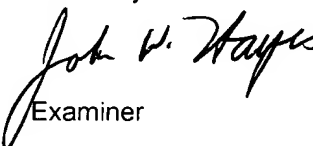
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammell, can be reached on (703) 305-9768.

The Fax phone number for the **UNOFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 746-5531 (for informal or draft communications, please label "PROPOSED" or "DRAFT").

The Fax phone number for the **OFFICIAL FAX** for the organization where this application or proceeding is assigned is (703) 305-7687 (for formal communications intended for entry including After-Final communications).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

John Hayes



Examiner

19 June 2002